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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/835,424	04/16/2001	Terry O'Brien	VLIK.73135	5505
5251	7590	08/17/2004	EXAMINER	
SHOOK, HARDY & BACON LLP 2555 GRAND BLVD KANSAS CITY,, MO 64108			PARTHASARATHY, PRAMILA	
			ART UNIT	PAPER NUMBER
			2136	

DATE MAILED: 08/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/835,424

Applicant(s)

O'BRIEN, TERRY

Examiner

Pramila Parthasarathy

Art Unit

2136

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to the communication filed on 04/16/2001.
Claims 1 – 16 were received for consideration. No preliminary amendments to the claims were filed. Claims 1 – 16 are currently being considered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-16 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Pierce et al. (Patent Number 5,467,398).

Regarding Claim 1, Pierce teaches and describes, improved method of encryption for the transmission of information (Fig. 2-4 and Column 2 line 42 – Column 6 line 47) comprising the steps of:

creating an encryption key (Column 3 lines 27 – 52);

limiting access to an encryption key (Column 2 lines 42 – 58 and Column 4 lines 5 – 35);

registering an account owner (Column 3 lines 27 – 40); and

registering a communication device (Column 2 line 63 – Column 3 line 52).

Regarding Claim 7, Pierce teaches and describes, an apparatus for encryption utilizing a combination of hardware and software (Fig. 2-4 and Column 2 line 42 – Column 6 line 47) comprising:

- a Transmitting Device (Column 2 line 63 – Column 3 line 52);
- a Recipient Device (Column 3 lines 10 – 40);
- a message package (Column 3 line 27 – Column 4 line 54); and
- means for executing algorithm for encryption, decryption and registration (Column 3 line 27 – Column 4 line 35).

Regarding Claim 9, Pierce teaches and describes, a method for secure communication encryption utilizing a combination of hardware and software (Fig. 2-4 and Column 2 line 42 – Column 6 line 47) comprising:

- bundling of information into a message package (Column 2 lines 44 – 53);
- sending information via a Transmitting Device (Column 3 lines 54 – 64);
- receiving information via a Recipient Device (Column 4 lines 26 – 35); and
- executing algorithms for encryption, decryption and registration of component devices (Column 3 line 27 – Column 4 line 35).

Claim 2 is rejected as applied above in rejecting claim 1. Furthermore, Pierce teaches and describes improved method of encryption for the transmission of information (Fig. 2-4 and Column 2 line 42 – Column 6 line 47) wherein said access to the encryption key is limited to a Transmitting and a Receiving Device (Column 4 lines 16 – 21).

Claim 3 is rejected as applied above in rejecting claim 1. Furthermore, Pierce teaches and describes improved method of encryption for the transmission of information (Fig. 2-4 and Column 2 line 42 – Column 6 line 47) wherein said registration of an account comprises:

the registration of a device owner with a Recipient Device; and the registration of a Transmitting Device with a Recipient Device (Column 3 lines 32 – 58).

Claim 5 is rejected as applied above in rejecting claim 1. Furthermore, Pierce teaches and describes improved method of encryption for the transmission of information (Fig. 2-4 and Column 2 line 42 – Column 6 line 47) further comprising the step of integrating the encryption key with the communication device hardware (Column 3 lines 4 – 26).

Claim 6 is rejected as applied above in rejecting claim 1. Furthermore, Pierce teaches and describes improved method of encryption for the transmission of information (Fig. 2-4 and Column 2 line 42 – Column 6 line 47)

further comprising the step of encrypting and decrypting information at speeds that do not impede communication rates (Column 4 lines 5 – 31).

Claim 8 is rejected as applied above in rejecting claim 7. Furthermore, Pierce teaches and describes an apparatus for encryption utilizing a combination of hardware and software (Fig. 2-4 and Column 2 line 42 – Column 6 line 47) wherein said recipient device comprises:

a solid state device plug gable into a standard PC slot; a non-accessible and non-visible circuit card embedded on said solid state device; a connector for a network or similar communication medium; and a circuitry able to detect the disconnection of said solid state device from the PC (Column 2 line 63 – Column 3 line 26 and Column 5 lines 26 – 49).

Claim 10 is rejected as applied above in rejecting claim 9. Furthermore, Pierce teaches and describes a method for secure communication encryption utilizing a combination of hardware and software (Fig. 2-4 and Column 2 line 42 – Column 6 line 47) wherein said message package may precede or be appended to all messages and comprises:

a non-encrypted message Key and an identification of the sending device hardware (Column 3 lines 53 – 64).

Claim 14 is rejected as applied above in rejecting claim 9. Furthermore, Pierce teaches and describes a method for secure communication encryption utilizing a combination of hardware and software (Fig. 2-4 and Column 2 line 42 – Column 6 line 47) wherein the encryption, decryption and registration method comprises the steps of:

- formatting a master Key from sub-key components (Column 4 line 55 – Column 5 line 25);

- incorporating into the Key generation, the date and message number (Column 3 lines 27 – 45);

- retaining the master Key in memory (Column 5 lines 23 – 25);

- matching the information of the device on the opposite end of the communication with the information contained within the Key (Column 4 lines 5 – 25);

- allowing registration at any time of the day or night within a short time frame (a period of less than 30 seconds) (Column 2 line 63 – Column 3 line 52);
- and

- separating the Key from the data transmission (Column 6 lines 37 – 47).

Claim 4 is rejected as applied above in rejecting claim 3. Furthermore, Pierce teaches and describes improved method of encryption for the transmission of information (Fig. 2-4 and Column 2 line 42 – Column 6 line 47)

wherein said registration of an account occurs in an automated manner without user intervention.

Claim 13 is rejected as applied above in rejecting claim 12. Furthermore, Pierce teaches and describes a method for secure communication encryption utilizing a combination of hardware and software (Fig. 2-4 and Column 2 line 42 – Column 6 line 47) wherein said receiving of information occurs with respect to communications between a Recipient Device and a plurality of Transmitting Devices (Column 2 line 63 – Column 3 line 22) .

Claim 15 is rejected as applied above in rejecting claim 14. Furthermore, Pierce teaches and describes a method for secure communication encryption utilizing a combination of hardware and software (Fig. 2-4 and Column 2 line 42 – Column 6 line 47) wherein said master Key is formatted from sub-key components that include:

user account Key (Column 2 lines 1 – 12; Column 3 lines 27 – 40 and Column 5 lines 50 – 60);

recipient account Key (Column 2 lines 1 – 12; Column 3 lines 27 – 40 and Column 5 lines 50 – 60);

Sending Device authentication Key (Column 4 lines 5 – 48);

Recipient Device authentication Key (Column 4 lines 5 – 25);

Date and message number (Column 3 lines 27 – 45); and

certificate of authenticity (Column 4 lines 10 – 21) .

Claim 16 is rejected as applied above in rejecting claim 14. Furthermore, Pierce teaches and describes a method for secure communication encryption utilizing a combination of hardware and software (Fig. 2-4 and Column 2 line 42 – Column 6 line 47) wherein said formatting of master Key comprise the steps of:

Generating new User Account Numbers (UAN) in the Recipient Device; accepting a manually entered User Account Number (UAN) in the sending device; creating a User Account Key (UAK) associated with the user account number (UAN); connecting the Sending Device with the Recipient Device and transmitting the UAN; verifying the received UAN and responding with a recipient account Key (MK); sending a UAK in response to an RAK (Column 2 lines 1 – 12; Column 2 line 63 – Column 4 line 48; Column 5 lines 50 –60); and performing an exclusive or of RAK and UAK on both ends for the communication to obtain a master authentication Key (Column 4 line 55 – Column 5 line 25).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierce et al. (Patent Number 5,467,398) in view of Stringfellow, Jr. (Patent Number 5,652,759).

Claim 11 is rejected as applied above in rejecting claim 9. Furthermore, Pierce teaches and describes a method for secure communication encryption utilizing a combination of hardware and software (Fig. 2-4 and Column 2 line 42 – Column 6 line 47) wherein said sending of information comprises:

- registering said recipient device (Column 3 lines 10- 40);
- establishing a master key that is locally stored (Column 4 lines 5 – 21);
- implementing software programs to prevent access to account keys (Column 4 lines 26-35);

- executing an encryption algorithm (Column 3 line 27 – Column 4 line 35).

Pierce does not explicitly teach that the sending information comprises allowing real time audio or audio/visual communications; and sending files (Column 3 54 – 64). However, Stringfellow discloses a method and apparatus of delivering digital video, audio and files via digital network in a real time mode (Column 1 line 16 – Column 2 line 30). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the use of encryption key along with authentication of the registered device to provide secure communication as taught by Pierce with the teachings of Stringfellow to provide an additional service of allowing real time audio/visual communications and sending files.

Claim 12 is rejected as applied above in rejecting claim 9. Furthermore, Pierce teaches and describes a method for secure communication encryption utilizing a combination of hardware and software (Fig. 2-4 and Column 2 line 42 – Column 6 line 47) wherein said receiving of information comprises:

- executing a decryption algorithm (Column 3 line 27 – Column 4 line 35);
- registering said transmitting device (Column 2 line 63 – Column 3 line 52);
- establishing a master Key that is locally stored (Column 4 lines 5 – 21);

and implementing software programs to prevent access to account Keys (Column 4 lines 26-35). Pierce does not explicitly teach that the sending information comprises receiving files; allowing the real-time audio or audio/visual conversations over a digital network (Column 3 54 – 64). However, Stringfellow discloses a method and apparatus of delivering digital video, audio and files via digital network in a real time mode (Column 1 line 16 – Column 2 line 30). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the use of encryption key along with authentication of the registered device to provide secure communication as taught by Pierce with the teachings of Stringfellow to provide an additional service of allowing real time audio/visual communications and sending files.

Conclusion

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks, Washington, D.C.

20231 **or faxed to:** (703) 872-9306 for all formal communications.

Hand-delivered responses should be brought to Crystal Park II, 2121


Crystal Drive, Arlington, VA, Fourth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pramila Parthasarathy whose telephone number is 703-305-8912. The examiner can normally be reached on 8:00a.m. To 5:00p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 703-305-9648. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Pramila Parthasarathy
Patent Examiner
703-305-8912
August 09, 2004


AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100